

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

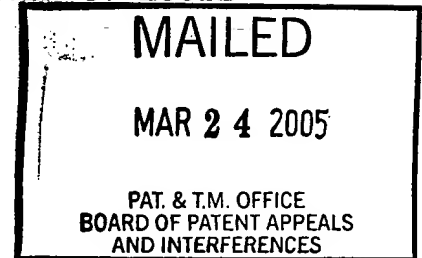
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. PISKOTI, ALEX K. ZETTL, MARVIN L. COHEN,
MICHEL COTE, JEFFREY C. GROSSMAN, and STEVEN G. LOUIE

Appeal No. 2005-0268
Application No. 09/518,989

ON BRIEF



Before GARRIS, HANLON, and WARREN, Administrative Patent Judges.
HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 involving twice-rejected claims 1 through 5 and 10. Claims 6 through 9 are also pending but have been allowed by the examiner. See Answer, p. 1.

The claims on appeal relate to a solid state material consisting essentially of C₃₆ fullerene molecules. Claims 1 and 5 are illustrative of the subject matter on appeal and read as follows:

1. A composition of matter comprising a solid state material consisting essentially of C_{36} fullerene molecules.

5. An article of manufacture comprising a coating formed of a solid state C_{36} material.

The sole issue on appeal¹ is whether claims 1 through 5 and 10 were properly rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over an article by Stankevich et al.²

Discussion

The examiner argues that the Stankevich article discloses C_{36} . See Table 1 of the Stankevich article. However, appellants argue that the rejection is erroneous because the Stankevich article does not contain an enabling disclosure of C_{36} . See Supplemental Brief, pp. 12 and 14.

To constitute a bar under 35 U.S.C. § 102, the Stankevich article must provide an "enabling" description of C_{36} . In re

¹Claims 1 through 10 were also rejected under 35 U.S.C. § 112, first paragraph, based on written description and under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over a Service article and/or a Nature article. See Office action mailed on November 4, 2003, p. 2. However, these rejections were withdrawn by the examiner in the Answer. See Answer, p. 2.

²I.V. Stankevich, et al., "Polyhedral Carbon Clusters C_{36+12n} ($n \geq 0$) and their Hydrocarbon Analogs as Predecessors of (6,0)-Tubular Structures," 10 Mol. Mat., pp. 169-74 (1998) (hereinafter "Stankevich").

Appeal No. 2005-0268
Application No. 09/518,989

Hoeksema, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968); see also Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987) ("[b]efore answering *Graham's* "content" inquiry [under 35 U.S.C. § 103], it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102"). The proper standard for determining whether a publication contains an "enabling" description:

[R]equires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.

In re LeGrice, 301 F.2d 929, 939, 133 USPQ 365, 374 (CCPA 1962).

The Court in In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985), further explains that:

[P]ossession [of the invention] is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. [Citations omitted.]

See also In re Brown, 329 F.2d 1006, 1010-11, 141 USPQ 245, 248 (CCPA 1964) (the mere printed conception or the mere printed contemplation which constitutes the designation of a "compound"

Appeal No. 2005-0268
Application No. 09/518,989

is not sufficient to show that the compound is old, regardless of whether the compound is involved in a 35 U.S.C. § 102 or 35 U.S.C. § 103 rejection); Hoeksema, 399 F.2d at 274, 158 USPQ at 601 (if the prior art fails to disclose or render obvious a method for making a claimed compound, it may not be legally concluded that the compound itself is in the possession of the public).

In this case, the examiner does not address whether the Stankevich article, either alone or in combination with other prior art, would have taught one of ordinary skill in the art how to make C₃₆. See Ex parte Wall, 156 USPQ 95, 96 (Bd. Pat. App. 1964) (in reversing examiner, board commented that examiner neither contends that reference discloses how compound is made nor points to any extraneous evidence which would indicate that those skilled in the art know how to make compound).

Rather, the examiner recognizes that Stankevich does not disclose a method for synthesizing C₃₆ and merely contends that C₃₆ "appears" to have been made and isolated because several properties of C₃₆ are reported in the article. See Table 1 of the Stankevich article (reporting ionization potentials and heats of formation). Appellants, on the other hand, argue that the

Appeal No. 2005-0268
Application No. 09/518,989

values reported in Table 1 are "purely theoretical calculations."
Supplemental Brief, p. 13.

We agree with appellants. Significantly, the first sentence
of the Stankevich article states (p. 169):

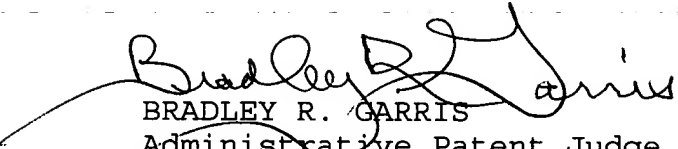

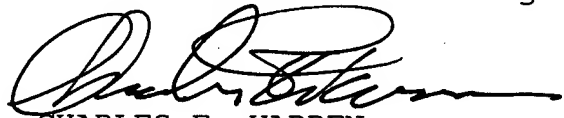
The inexhaustibility of allotropic species of carbon,
supported by recent theoretical predictions and
experimental demonstrations stimulates further modeling
of various carbon cluster structures and prognosis of
their properties. [Emphasis added; footnotes omitted.]

For the reasons set forth above, the examiner has failed to
establish that the Stankevich article provides an enabling
disclosure of the claimed invention. Therefore, we are
constrained to reverse the rejection of claims 1 through 5 and
10 under 35 U.S.C. § 102(a) as anticipated by or, in the
alternative, under 35 U.S.C. § 103(a) as obvious over the
Stankevich article. See In re Oetiker, 977 F.2d 1443, 1445,
24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (the examiner bears the

Appeal No. 2005-0268
Application No. 09/518,989

initial burden of presenting a prima facie case of
unpatentability).

REVERSED


BRADLEY R. GARRIS)
Administrative Patent Judge)

ADRIENE LEPIANE HANLON)
Administrative Patent Judge)

CHARLES F. WARREN)
Administrative Patent Judge)

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Appeal No. 2005-0268
Application No. 09/518,989

HENRY P. SARTORIO
LAWRENCE BERKELEY NAT'L LAB
PATENT DEPT.
ONE CYCLOTRON RD.
MS 90 1121
BERKELEY, CA 94720